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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

24772-08114

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on \_\_\_\_\_

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Typed or printed name \_\_\_\_\_

Application Number

10/759,597

Filed

January 15, 2004

First Named Inventor

Richard J. Donald

Art Unit

2617

Examiner

Christopher M. Brandt

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/Brian G. Brannon/

☐ assignee of record of the entire interest.

Signature

Brian G. Brannon

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

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May 21, 2008

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW IN U.S.  
PATENT APPLICATION NO. 10/759,597 FILED ON JANUARY 15, 2004**

Pre-appeal brief review is appropriate in this application because the rejections in the Final Office Action dated February 21, 2008 contain clear deficiencies. As set forth below, because the cited references fail to include any disclosure of essential claim elements these rejections are improper.

**CLAIMS 1-10, 13-15, 17, 18, 21, 22, 30-45, 48-50, 53-59, 61-63, 65, 68-72, 75-78, 80-83, 85-89 AND 95-97 ARE NOT OBVIOUS IN VIEW OF THE CITED REFERENCES**

Claims 1-10, 13-15, 17, 18, 21, 22, 30-45, 48-50, 53-59, 61-63, 65, 68-72, 75-78, 80-83, 85-89 and 95-97 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent Publication No. 2004/0185883 to Rukman ("Rukman"), U.S. Patent Publication No. 2003/0114174 to Walsh et al. ("Walsh"), MacLeod Beck et al. ("Beck") and U.S. Patent Publication No. 2004/0137884 to Engstrom et al. ("Engstrom").

Representative claim 1 recites "applying a set of incoming SMS message rules to incoming SMS message and applying a set of outgoing SMS message rules to outgoing SMS messages, the outgoing SMS message rules different from the incoming SMS message rules." The claimed invention displays related Short Message Service (SMS) messages as a message thread. To determine whether to thread one or more SMS messages, a set of incoming SMS message rules are applied to incoming SMS messages and a different set of outgoing SMS message rules are applied to outgoing SMS messages. By applying different SMS message rules to incoming SMS messages and outgoing SMS messages, the claimed invention increases customization of thread generation or modification. This allows use of different criteria for determining whether to thread incoming or outgoing messages. For example, incoming message rules examine the message sender and prevent threading of messages originating from known spammers, commercial entities or other user-specified entities. Similarly, outgoing SMS message rules can then deter-

minimize the relationship between sent and received SMS messages using different criteria, such as threading outgoing messages sent to entities listed in a contact list or preventing threading of messages older than a specified time interval. Hence, incoming and outgoing message threads are independently generated and/or modified using different sets of message rules.

Rukman discloses identifying and organizing related messages using message text, such as a subject line. However, Rukman fails to disclose “outgoing SMS message rules different from the incoming SMS message rules.” Rather, Rukman describes using a single parameter, e.g., subject text or message time, to organize both incoming and outgoing message threads rather than applying different message rules to incoming and outgoing SMS messages. *See* Rukman, ¶ [0028], [0033]-[0034], [0047]. For example, Rukman uses the contents of the message subject line (e.g., the number of times “RE:” appears in the subject line or a number in the subject line) to organize messages, regardless of whether the message is incoming or outgoing. *See* Rukman, ¶ [0047]. Hence, Rukman does not apply different message rules to incoming messages and outgoing messages.

Walsh also does not disclose “outgoing SMS message rules different from the incoming SMS message rules,” as claimed. Walsh discloses incorporating a message thread identifier into a message and using the thread identifier to determine a thread associated with the message. *See* Walsh, Abstract; ¶¶ [0005]-[0006]. Hence, Walsh uses the embedded thread identifier to organize messages and facilitate replying to previously received messages rather than apply a set of incoming SMS message rules and a different set of outgoing SMS message rules to incoming and outgoing SMS messages, respectively. Rather than embed a thread identifier into messages, which increases the processing associated with each message, the claimed invention applies incoming SMS message rules and different outgoing SMS message rules to incoming SMS messages and outgoing SMS messages to generate or modify one or more message threads.

Beck also fails to disclose “outgoing SMS message rules different from the incoming SMS message rules,” as claimed. Beck discloses a multimedia communication center (MMCC) for accepting communication from clients and displaying an interactive self-help wizard in a graphic interface. *See* Beck, ¶¶ [0025]-[0027]. The MMCC stores text-based and multimedia-based interactions in a repository for subsequent retrieval and analysis. *See* Beck, ¶¶ [0140]-[0142]. Beck does not disclose applying different threading rules to input SMS messages and output SMS messages, but merely applies business rules to all interactions, both incoming and outgoing, of a particular transmission type by assigning an identifier to an entity and organizes or stores interactions based on that identifier. *See* Beck, ¶ [0159]. Hence, Beck merely examines an interaction for an identifier and organizes all interactions, regardless of whether the interactions are outgoing transmissions or incoming receipts, according to the identifier without applying different message rules to incoming and outgoing messages. *See* Beck, ¶¶ [0159]-[0165]. Hence, Rukman, Walsh and Beck, both alone and in combination, fail to disclose “outgoing SMS message rules different from the incoming SMS message rules,” as claimed.

Engstrom also fails to remedy the deficient disclosure of Rukman, Walsh and Beck. Rather, Engstrom discloses a mobile communication device with a unified message function allowing a user to interact with a communication partner using various message types. *See* Engstrom, Abstract. Engstrom merely allows a user to receive messages having different formats using a single inbox or to generate a thread including different types of messages. *See* Engstrom, ¶ [0018], [0019]. However, Engstrom fails to disclose “outgoing SMS message rules different from the incoming SMS message rules,” as claimed, but merely allows a user to group incoming and outgoing messages into a thread based on message type.

In the Final Office Action dated February 21, 2008, the Examiner cites ¶ [0045] or Engstrom as allegedly disclosing incoming SMS message rules that are different from outgoing SMS

message rules. However, ¶ [0045] of Engstrom merely discloses that a user can respond to a received message using a format different than the format of the received message. For example, rather than replying to a received email with another email, a user can reply using a voice call or text message. The cited portion of Engstrom merely provides that incoming and reply messages can have different types, which is unrelated to message threading, as Engstrom groups messages together regardless of message format. In contrast, the claimed invention determines whether or not to thread SMS messages based on different “incoming SMS message rules” and “outgoing SMS message rules.”

As claims 2-10, 12-15, 17-19, 21, 22 and 68-72 are dependent on claim 1, all arguments advanced above with respect to claim 1 are hereby incorporated so as to apply to claims 2-10, 12-15, 17-19, 21, 22 and 68-72. Hence, claims 2-10, 12-15, 17-19, 21, 22 and 68-72 are patentable over the cited references, both alone and in combination.

Independent claims 30, 53 and 85 have been similarly amended to recite a “set of outgoing SMS message rules are different from the set of incoming SMS message rules” or “the outgoing SMS message rules different from the incoming SMS message rules.” Therefore, all arguments advanced above with respect to claim 1 are also applicable to claims 30, 53 and 85. Hence, claims 30, 53 and 85 are patentable over the cited references, both alone and in combination. As claims 31-45, 48-50, 75-78, 54-59, 61-63, 65, 80-83 and 86-88 variously depend from claims 30, 53 and 85, all arguments advanced above with respect to claim 1 are also applicable to these claims, which are also patentable over the cited references, both alone and in combination.

**CLAIMS 16, 19, 46, 47, 64, 66 AND 67 ARE NOT OBVIOUS IN VIEW OF THE CITED REFERENCES**

Claims 19, 46, 47, 64, 66 and 67 have been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable in view of Rukman, Walsh, Beck, Engstrom and U.S. Patent Publication No. 2001/0006889 to Kraft (“Kraft”). As claims 16, 46, 47, 64, 66 and 67 variously depend from

independent claims 1, 30, 53 and 85, all arguments advanced above with respect to claim 1 are hereby incorporated so as to apply to claims 19, 46, 47, 64, 66 and 67. Further, Kraft merely discloses a method for handling a message exchange session where the message history, or a portion of the message history, is transmitted between terminals during the message exchange session and also fails to disclose “a set of outgoing SMS message rules to outgoing SMS messages, the outgoing SMS message rules different from the incoming SMS message rules.” *See* Kraft, ¶¶ [0004]-[0005]. Hence, claims 19, 46, 47, 64, 66 and 67 are patentable over the cited references both alone and in combination.

**CLAIM 20 IS NOT OBVIOUS IN VIEW OF THE CITED REFERENCES**

Claim 20 has been rejected under 35 U.S.C. 103(a) as allegedly being unpatentable in view of Rukman, Walsh, Beck, Engstrom and U.S. Patent No. 6,799,033 to Kanefsky (“Kanefsky”). As claim 20 depends from independent claim 1, all arguments advanced above with respect to claim 1 are hereby incorporated so as to apply to claim 20. Kanefsky merely discloses a mobile telephone text messaging device which displays static text from past messages and a message composition field for inputting text and does not disclose “a set of outgoing SMS message rules to outgoing SMS messages, the outgoing SMS message rules different from the incoming SMS message rules.” *See* Kanefsky, col. 1, lines 47-65. Hence, claim 20 is patentable over the cited references, both alone and in combination.

Respectfully submitted,

Lawrence Lam, et al.

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